

REMARKS

In the Office Action of September 23, 2008, the Examiner rejected claims 15-19, 26, 30, 33 and 34 under 35 USC 102(b) as being anticipated by Baumann U.S. Patent No. 5,538,626 (Baumann). Claims 20-25, 31, 32 and 35 were rejected under 35 USC 103(a) as being unpatentable over Baumann in view of Koivula, et al, U.S. Patent No. 6,187,191 (Koivula) and Steger, Jr. et al, U.S. Patent No. 6,554,140 (Steger).

Applicant respectfully submits that Baumann does not anticipate independent claims 15 and 33 of the present application and therefore, all of the claims are patentable over the references relied on by the Examiner.

Specifically, independent claims 15 and 33 require that the sealing plate is a separate part from the filter socket which structural feature is not shown or suggested by the face wall 20 of Baumann, which the Examiner equates with the claimed sealing plate. For example, in claim 15 it is specified that the sealing plate is "inserted in said filter socket" which clearly indicates that the sealing plate is separate from the filter socket. Further, the face wall 20 of Baumann extends to the outside periphery (circumferential wall 24) of the housing and is specifically defined to carry "an annular channel 21" and therefore, the surface area of the face wall 20 is not smaller than a surface area of the mounting flange 24 as also specifically required by independent claim 15.

That the face wall 20 of Baumann is integrally formed with the housing is confirmed in that a hollow screw 2 is rotatably and centrally inserted in the face wall, which screw forms the return channel. In its tightened state, the screw engages with a screw head behind the face wall and via this face wall presses the filter housing 2 against the counter flange 7. This pressing would not be possible at all if the face wall was a separate part inserted from outside into the flange side of the filter housing.

Claim 15 further defines that the sealing plate has an opening that is sealed against the companion flange and is arranged flush with an apparatus-side fluid duct. The intake channel 23 of Baumann is not separately sealed against the flange 7, but rather relies on the seal ring 22 carried on the face wall 20. The filter housing 2 is secured by means of the screw 3, however, the position of the filter housing in a circumferential direction is purely incidental. That is, it is only by chance whether, after the filter is attached at the counter flange 7,

whether the inlet channel 23 is aligned (flush) with the intake channel 73. For this reason, the face wall 20 is not planar where it abuts the counter flange 7, but rather it forms a circular ring channel so that the inlet channel 23 will communicate with the intake channel, despite their misalignment.

Claim 15 also requires that at least one fluid duct for supplying fluid to be filtered and one fluid duct for discharging filtered fluid extend through the flange connection. In Baumann, these ducts extend through the face wall 20, not the circumferential wall 24, which the Examiner equates with the flange connection.

For each of these reasons separately and in combination, applicant submits that Baumann does not disclose all of the structural limitations defined in claim 15, and that therefore, claim 15 is not anticipated by Baumann. A single prior art document must describe every element of the claimed invention, *Xerox Corp. v. 3Com Corp.*, 458 F.3d 1310, 1322 (Fed. Cir. 2006) and those elements must be arranged as in the claims, *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1538 (Fed. Cir. 1983), *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1334 (Fed. Cir. 2008). Based on this guidance, it is clear that the Baumann reference does not anticipate claim 15.

Claim 33 also defines the sealing plate as being separate from the filter socket ("said sealing plate being inserted in said filter socket), it defines three ducts extending through the flange connection, including an unpressurized drain duct, it defines that the sealing plate is sealed against the companion flange, is arranged flush with an engine-side fluid duct, and that the surface area of the sealing plate, as seen on a plane of the flange connection, is smaller than a surface area of the mounting flange. Nearly all of these structural requirements are discussed above with regard to claim 15, and the deficiencies of Baumann with regard to each have been pointed out. With regard to the unpressurized drain duct, Baumann teaches to provide a drain duct 25 through the circumferential wall 24, rather than through the flange connection, thereby representing yet another structural difference. For each of these reasons taken separately and in combination, as discussed above, applicant submits that claim 33 is not anticipated by Baumann.

The Examiner relied on the additional teachings of Koivula and Steger in combination with the teachings of Baumann in an attempt to develop a prima facie case of obviousness of some of the dependent claims. These two additional references do not provide any of the

missing teachings relative to independent claims 15 or 33 as discussed above, and therefore independent claims 15 and 33 are deemed patentable over all of the references relied on by the Examiner. In view of the patentable condition of claims 15 and 33, applicant submits that each of the claims depending on claims 15 and 33 are patentable as well.

In view of the above discussion, applicant submits that the application is now in condition for allowance and therefore requests the Examiner to reconsider the rejections made, to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

/Kevin W. Guynn/ (Reg. No. 29,927)
Kevin W. Guynn
GREER, BURNS & CRAIN, LTD
Customer Account No. 24978
300 S. Wacker Drive, Suite 2500
Chicago, Illinois 60606-6771
Telephone (312) 987-2917
Attorneys for Applicant